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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,338	02/25/2002	James Roddis	31229-178398	1368
26694	7590	02/05/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP			ZIMMER, MARC S	
P.O. BOX 34385			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20043-9998			1712	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,338

Applicant(s)

RODDIS, JAMES

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,10,14,17,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 2,5-9,11,12,15,16,18-21,24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicant alleges that *Hesterman, Lee, and Orlowski* all fail to anticipate the claims as amended because they do not disclose glass *granules*. However, to reiterate, Applicant has not expressly delineated what constitutes a granule. Indeed, the Examiner raised this issue previously stating that "granule" was, for the purpose of evaluating the instant invention against the prior art, taken to represent a particle adhering to certain geometrical constraints, as opposed to size limitations. That is, references disclosing a composite comprising, for instance, a thermoset resin and glass flakes, would be considered non-anticipatory, due to a high aspect ratio. Notably, Applicant did not comment as to whether the term "granules" had an art-accepted definition associated with it in their response.

The aforementioned references are, nonetheless, obviated by the amendments made to the claims because they are all silent regarding the presence of glass particles having a dimension in the range of 4 to 6 mm.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim is not specific as to what type of ratio is being recited nor does the

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Specification clarify this matter. (Although the ratios mentioned in claims 16 and 21 also are not expressly delineated as weight ratios by the original disclosure, the Examples would seem to support the notion that said ratios are, in fact, weight ratios since the quantities of the binder and glass granules are provided in terms of their weight contributions. On the other hand, there is no Example wherein a reactive diluent has been incorporated hence it cannot be ascertained with absolute certainty that the ratio reported in claim 14 is also intended to be a weight ratio.)

Having considered the context of the entire Specification, it seems apparent that the ratio in claim 14 was to have been a weight ratio. Applicant's next response should be accompanied by a rule 1.132 declaration that confirms this presumption.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, 10, 17, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hyodo, JP 07-090805. Hyodo discloses a paving composition comprising an epoxy resin binder, colored glass, and fluorescent colored glass having a grain size of 2-10 mm. The binder component comprises between 6 and 12 wt.% of the total weight of the materials. Relevant to claim 4, industrial waste glass is employed in preparing the paving composition. The product obtained upon curing the above mixture of materials is equivalent to the claimed composite.

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***Allowable Subject Matter***

Claims 2, 5-9, 11-12, 15-16, 18-21, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 25 is allowable. The reference does not disclose the utilization of coupling agents, reactive diluents or the specific bulking sources contemplated in claim 2 though gravel is mentioned as a reinforcing additive. Also, though fluorescent colored glass particles having a particle size of 2 to 10 mm is disclosed, there is no further information provided as to the weight distribution of the particles having a size within the specified range.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

January 27, 2004



MARGARET G. MOORE  
PRIMARY EXAMINER